



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,926	01/18/2001	Alan John Lunn	12805-002001	9930

26161 7590 09/15/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

NGUYEN, ANTHONY H

ART UNIT	PAPER NUMBER
----------	--------------

2854

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,926

Applicant(s)

LUNN, ALAN JOHN

Examiner

Anthony H Nguyen

Art Unit

2854

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, and 53- 57 is/are allowed.
- 6) ☒ Claim(s) 14, 15, 24-27, 30, 31, 40-45 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 16-23, 28, 29, 33-39 and 46-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 14,15,24-27, 30,31, 40-44 are rejected under 35 U.S.C. 102(a) as being anticipated by Troester (US 6,135,022).

With respect to claims 1, 25, 30, 41 and 42, Troester teaches a marking device 10 having a housing 50 (Fig.3), a frame pivotally mounted in the housing about an axis 30, a marking head 14 which includes a head pin 12 that is actuated by a solenoid (not shown, Troester, col.10 line 13). The marking head is mounted in the carriage 15 which is moved parallel to the pivoted axis by a motor 28, and a motor 22 is used to pivot the frame in a substantially orthogonal direction and a handle 82 (Fig.4B). Note that the elements of Troester are contained in the housing therefore the recoils of the marking head does not cause moments about the device's center of gravity.

With respect to claims 15 and 31, Troester teaches the use of a console or a controller 70, a handle 82 having a trigger 84 for operating the device as shown in Figs. 4A and 4B.

With respect to claims 24 and 40, Fig.3 of Troester shows the housing 50 having a window (no reference) through which the marking head 14 protrudes between the standoffs 48.

With respect to claims 26,27, 43,44, Troester teaches the head carriage 15 on which the marking head 14 is mounted for sliding along the guide rods or rails 24 and 26 in the first direction.

Art Unit: 2854

Claim 45 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Wadge (US 6,263,980).

With respect to claim 45, Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach the housing which is a clamshell housing. However, Wadge teaches a power tool 2 having a clamshell housing 4 that includes ribs 30 which function as a bearing bush to secure a motor 22 in place. In view of the teaching of Wadge, it would have been obvious to one of ordinary skill in the art to modify the housing of the marking device of Troester by substituting the clamshell housing as taught by Wadge for simplicity of producing a housing of a marking device

Allowable Subject Matter

Claims 1-13, and 53-77 are allowable.

Claims 16, 7-23, 28, 29, 33-39 and 46-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 1 and 56, the prior art of record does not teach the frame pivotally connected to a housing about the first axis and the housing which supports the frame and second motor with respect to one another as argued by applicant in the Remarks (page 13, the last four lines).

With respect to claims 16, 17, 34 and 53-56, the prior art of record does not teach the screw of the first motor being fixed in the frame.

Response to Arguments

Applicants' arguments filed on July 11, 2003 have been fully considered but they are not persuasive of any error in the above rejections. Applicant argues that Troester, Robertson et al., Curreno, and Wadge fail to teach or suggest the marking device as recited. Specifically, applicant argues that Troester does not teach or suggest the recoil of the marking head by the driving means that do not cause moments about the center of gravity as recited in claim 14.

However, as explained above, while Troester does not specifically state that the marking device does not cause moments about its center of gravity, the device is inherently stable and does not cause moments about its center of gravity since all components of Troester are contained in the housing. Note also that the center of gravity of the device is depending on the angle or the position of the device during operation so that the moments created by the driving means is eliminated (see Troester, Figs.4A and 4B). Thus, Troester meets the structure as recited in the claim.

Applicant argues that Troester does not teach or suggest the motor which are disposed substantially within the confines of the frame as recited in claim 30.

Note that Figs 1 and 2 of Troester show the motors 22 and 28 which are substantially within the confines in the frame 28 via a motor mount 38. Therefore, Troester clearly anticipated claim 30.

Applicant argues that Troester and does not teach or suggest that the marking head, rail, and the rotational axis of the first motor are placed in the same plane as recited in claim 53.

Troester teaches the components which are place in line in a plane. For example, Fig.2 of Troester shows the first motor 22, rail 24 and the marking head 14 are placed in a line which is parallel and a plan through the axis of the motor 28.

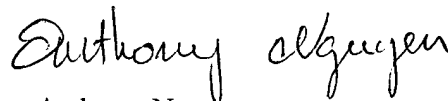
Art Unit: 2854

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (703) 308-2869. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (703) 305-6619. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Anthony Nguyen
9/11/03
Patent Examiner
Technology Center 2800